

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

(Attorney Docket No. 14287US02)

In the Application of:

Jeyhan Karaoguz, et al.

Electronically Filed on 05-JAN-2007

Serial No. 10/675,122

Filed: September 30, 2003

For: PORTABLE MEDIA
PROCESSING UNIT IN A
MEDIA EXCHANGE NETWORK

Examiner: Diane D. Mizrahi

Group Art Unit: 2165

Confirmation No. 4964

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicant requests review of the final rejection in the above-identified application, stated in the final Office Action mailed on October 5, 2006 (hereinafter, the Final Office Action) with a period of reply through January 5, 2007. The Applicant also requests review of the arguments stated on page 2 of the Advisory Office Action mailed on December 27, 2006 (hereinafter, the Advisory Office Action). No amendments are being filed with this request.

This request is being filed with a Notice of Appeal. The review is being requested for the reasons stated on the attached sheets.

REMARKS

The present application includes pending claims 1-32, all of which have been rejected. Claims 1-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2003/0093485, issued to Dougall et al. (hereinafter, Dougall), in view of U.S. Publication No. 2002/0166123, issued to Schrader et al. (hereinafter, Schrader). The Applicant respectfully submits that the claims define patentable subject matter. The Applicant also respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

I. The Examiner's Arguments in the Advisory Office Action

The Examiner states the following on page 2 of the Advisory Office Action:

Regarding Applicant's comment that Examiner did not establish a prima facie case for motivation, Examiner asserts that the combination of Dougall and Shrader teaches Applicant's invention. The motivation as in combination with Dougall and Schrader is to enhance television viewing experience to users in a system and .. that utilizes real time and/or other data that is linked together with broadcast television programming, (Shrader, [0009]). Examiner is aware of the Examiner's Manual of Patent Examining and thanks Applicant for advising the Examiner of such a manual. Yet, Examiner maintains the final office action of 10-5-06, because the claimed invention is expressly taught by both Dougall and Shrader. Ergo, claims 1-32 are not allowable over the prior art made of record. (emphasis added)

It seems that the Examiner's response in the Advisory Office Action is addressing only the Applicant's remarks with regard to the criteria for establishing obviousness as stated in the MPEP. See the December 4, 2006 response to the Final Office Action, pages 15-16. The Applicant notes that the substantive argument with regard to allowability of claims 1-32 may be found under section I.A – I.C of the December 4, 2006 response to the Final Office Action, at pages 16-20. *The Examiner has not responded to any of the Applicant's arguments in the above-identified sections I.A – I.C of the December 4, 2006 response. For convenience, the Applicant is restating these arguments herein below.*

II. The Proposed Combination of Dougall and Schrader Does Not Render Claims 1-32 Unpatentable

The Applicant turns to the rejection of claims 1-32 as being unpatentable over Dougall in view of Schrader. The Applicant notes that the proposed combination of Dougall and Schrader forms the basis for all of the pending rejections.

A. The Proposed Combination Does Not Teach or Suggest “Transferring a Storage Unit From a First Location to a Second Location” (First Claim Limitation)

With regard to the rejection of independent claim 1 under 103(a), the Applicant submits that the combination of Dougall and Schrader does not disclose or suggest at least the limitation of “storing media and metadata ... on a storage unit ... at a first location and if said storage unit is transferred to a second location and coupled to a second communication device at said second location ... presenting ... a channel guide,” as claimed by the Applicant in independent claim 1. More specifically, *Dougall does not teach storing media and meta data associated with the media on a **storage unit** coupled to a communication device **at a first location**, and **transferring the storage unit to a second location** and coupling it to a second communication device at the second location.* In the Final Office Action, the Examiner states the following:

Regarding Claim 1, 11, and 21, Dougall teaches porting information between locations in a communication network[0034], the method comprising: storing media along with meta data associated with said stored media on a storage unit coupled to a communication device at a first location; if said storage unit is transferred to a second location and coupled to a second communication device at said second location, presenting a channel guide comprising representations of said stored media on a television [0061][0069] in said second location [0129][0023]; and in response to receiving a selection via said presented channel guide[0129], displaying at least one media file corresponding to said received selection on at least one of said television and a media player in said second location[0023].

See the Final Office Action at page 3. The Applicant respectfully disagrees with the Examiner’s argument. The Applicant points out that the Examiner has cited paragraphs 0061, 0069, 0129, and 0023 of Dougall in support of the First Claim Limitation. Paragraph 0061 of Dougall discloses a general network architecture of Figure 1, and paragraph 0069 discloses a router node 230 and client nodes 240. Paragraph 0129 of Dougall discloses providing of service announcements by the session manager 820, and paragraph 0023 discloses delivery of best-efforts data and real-time data. It is unclear what the Examiner is referring to by citing paragraphs 0061, 0069, 0129, and 0023 of

Dougall since *none of these paragraphs disclose or suggest the limitation of “storing media and metadata ... on a storage unit ... at a first location and if said storage unit is transferred to a second location and coupled to a second communication device at said second location ... presenting ... a channel guide,”* as claimed by the Applicant in independent claim 1. In fact, **neither Dougall nor Schrader disclose or suggest a storage unit or any other device that is coupled to a first communication device at a first location and, if transferred, the same storage unit is now coupled to a second communication device at a second location.**

Additionally, the Examiner states in the Final Office Action (page 3) that Dougall does not teach the limitation of “based on said meta data associated with said storage media on said transferred storage unit,” as called for in independent claim 1. The Applicant respectfully agrees.

Accordingly, the proposed combination of Dougall and Schrader does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is, therefore, allowable at least for the above reasons.

B. The Proposed Combination Does Not Teach or Suggest “Displaying Based On Said Meta Data ... On Said Transferred Storage Unit, At Least One Media File ... On Said Television ... In Said Second Location” (Second Claim Limitation)

With regard to the rejection of independent claim 1 under 103(a), the Applicant submits that the combination of Dougall and Schrader does not disclose or suggest at least the limitation of “displaying based on said meta data ... on said transferred storage unit, at least one media file ... on said television ... in said second location,” as recited by the Applicant in independent claim 1.

The Examiner refers for support to paragraph 0023 of Dougall. Paragraph 0023 of Dougall discloses delivery of best-efforts data and real-time data. Neither Dougall nor Schrader discloses storing of media and meta data on a storage unit at a first location, and, if the storage unit is transferred to a second location, displaying a media file on a TV in the second location **based on the meta data on the transferred storage unit.**

Accordingly, the proposed combination of Dougall and Schrader does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is, therefore, allowable at least for the above reasons. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the proposed combination of Dougall and Schrader at least for the reasons stated above with regard to claim 1.

C. Rejection of Dependent Claims 2-10, 12-20 and 22-32

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Dougall in view of Schrader has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-10, 12-20 and 22-32 depend from independent claims 1, 11 and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-32.

III. Conclusion

The Applicant respectfully submits that claims 1-32 of the present application should be in condition for allowance at least for the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn. The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Date: 05-JAN-2007

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